

REMARKS

This responds to the Advisory Action dated July 6, 2006 and the final Office Action dated March 31, 2006.

No claims are amended or cancelled. Claims 1-19 remain pending in this application.

Affirmation of Election

As provisionally elected without traverse, by Applicant's representative, Peter Maki, on March 30, 2006, Applicant elects to prosecute the invention of Group I, claims 1-8 and 16-19.

Response to Remarks in Advisory Action

In the Advisory Action, the Examiner stated that an argument had been presented to overcome a 103 rejection in view of a terminal disclaimer. Applicant believes that the 103 rejection referred to had been overcome by the Applicant filing a Statement of Common Ownership in the response filed 6/01/05.

The Examiner also states that the Terminal Disclaimer was not effective since it was not signed by an attorney of record. However, the terminal disclaimer filed 6/01/05 was signed by Suneel Arora, an attorney of record.

§103 Rejection of the Claims

Claims 1-5, 7-8 and 16-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bisping (U.S. Patent No. 4,886,074).

Claims 1-5 and 7-8

Applicant traverses the rejection of claim 1. Applicant believes claim 1 is not obvious over the cited reference since each limitation recited in the claim is not found in the cited reference. For instance, Applicant cannot find in Bisping a helix including non-soluble insulating material coated on at least a portion of its surface to conform to the outer surface of the helix, the insulating material including an active ingredient, as recited in claim 1.

The Office Action cites a number of references which allegedly contain such subject matter and the Office Action states it would be obvious to combine the references with the

Bisping reference. Applicant traverses. The references cited each have deficiencies and are not inherently combinable with the Bisping reference.

For example, the Dutcher reference discusses a sheath 133 on a wire 131 and a drug plug 138. However, even if combined with any of the cited references, the combined structure does not read on the claimed: non-soluble insulating material coated on at least a portion of its surface to conform to the outer surface of the helix, “the insulating material including an active ingredient.” For example, Applicant cannot find in the Pohndorf reference any discussion of an insulative coating. Struble does not include any discussion of an “insulating material including an active ingredient.” Altman discusses different coatings for an implantable device which is for “effective elimination of an arrhythmogenic site.” (Abstract). However, Applicant cannot find in Altman a non-soluble coating, as claimed. Moreover, there appears to be no motivation to apply any of Altman’s discussion to the lead of Bisping, since they are used for generally different purposes.

In the Advisory Action, the Examiner states that a “fixation device with insulation and an active material in the insulation,” is found in 5,902,329 (Hoffman) and 5,551,427 (Altman). Applicant traverses. However, Applicant cannot find in either of these references a “non-soluble insulating material coated on at least a portion of its surface to conform to the outer surface of the helix, the insulating material including an active ingredient,” as recited in claim 1.

Moreover, Applicant believes the Office Action has provided insufficient motivation to modify the cited reference. Applicant notes that the mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

Claims 2-5, 7, and 8 include each limitation of claim 1 and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 16-19

Applicant traverses the rejection of claim 16. Applicant believes claim 16 is not obvious over the cited reference since each limitation recited in the claim is not found in the cited reference. For instance, Applicant cannot find in Bisping, a fixation helix including a non-

soluble insulating material coated on at least a portion of its outer surface so as to conform to the outer surface of the helix, the insulating material including an active ingredient, as recited in claim 16. The discussion above for claim 1 is incorporated herein by reference.

Claims 17-19 include each limitation of claim 16 and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 1-3, 7-8 and 16-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grassi (U.S. Patent No. 4,624,265).

Claims 1-3, 7-8

Applicant traverses the rejection of claim 1. Applicant believes claim 1 is not obvious over the cited reference since each limitation recited in the claim is not found in the cited reference. For instance, Applicant cannot find in Grassi a helix including non-soluble insulating material coated on at least a portion of its surface to conform to the outer surface of the helix, the insulating material including an active ingredient, as recited in claim 1.

As noted above, the Office Action cites a number of references which allegedly contain such subject matter and the Office Action states it would be obvious to combine the references with the Grassi reference. Applicant traverses. The references cited each have deficiencies and are not inherently combinable with the Grassi reference. For example, the Dutcher reference discusses a sheath 133 on a wire 131 and a drug plug 138. However, even if combined, this does not read on the claimed: non-soluble insulating material coated on at least a portion of its surface to conform to the outer surface of the helix, “the insulating material including an active ingredient.” Applicant cannot find in the Pohndorf reference any discussion of an insulative coating. Struble does not include any discussion of an “insulating material including an active ingredient.” Altman discusses different coatings for an implantable device which is for “effective elimination of an arrhythmogenic site.” (Abstract). However, Applicant cannot find in Altman a non-soluble coating, as claimed. Moreover, there appears to be no motivation to apply any of Altman’s discussion to the lead of Grassi, since they are used for generally different purposes.

In the Advisory Action, the Examiner states that a “fixation device with insulation and an active material in the insulation,” is found in 5,902,329 (Hoffman) and 5,551,427 (Altman).

Applicant traverses. However, Applicant cannot find in either of these references a “non-soluble insulating material coated on at least a portion of its surface to conform to the outer surface of the helix, the insulating material including an active ingredient,” as recited in claim 1.

Moreover, Applicant believes the Office Action has provided insufficient motivation to modify the cited reference. Applicant notes that the mere fact that a reference can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

Claims 2-3, 7, and 8 include each limitation of claim 1 and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 16-19

Applicant believes claim 16 is not obvious over the cited reference since each limitation recited in the claim is not found in the cited reference. For instance, Applicant cannot find in Grassi, a fixation helix including a non-soluble insulating material coated on at least a portion of its outer surface so as to conform to the outer surface of the helix, the insulating material including an active ingredient, as recited in claim 16. The discussion above for claim 1 is incorporated herein by reference.

Claims 17-19 include each limitation of claim 16 and are therefore also not obvious in view of the cited reference. Reconsideration and allowance is respectfully requested.

Claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Grassi (U.S. Patent No. 4,624,265).

Claims 4 and 5 depend from claim 1 and are not obvious over the cited references for the reasons discussed about regarding claim 1. Reconsideration and allowance is respectfully requested.

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Bisping (U.S. Patent No. 4,886,074) or Grassi (U.S. Patent No. 4,624,265) as applied to claim 1 above.

Claim 6 depends from claim 1 and is not obvious over the cited references for the reasons discussed about regarding claim 1. Reconsideration and allowance is respectfully requested.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date 7/31/06

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 31 day of May, 2006.

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